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09/023,979 02/13/98 BURAKOFF

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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2771

DATE MAILED:

08/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/023,979

Applicant
Burakoff et al

Examiner
Mark Terry

Group Art Unit
2771



☒ Responsive to communication(s) filed on Aug 4, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4,5,6 ?

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-4, 8, and 9 are all rejected under 35 U.S.C. 102(e) as being anticipated by Kitain et al USPAT 5,864,871. Kitain discloses a system by which corporate financial information is stored and delivered. See Abstract.

As to Claims 1 and 8, Kitain discloses a system by which brokerage research information is stored and distributed. See col. 7 lines 14-19. The items in the database include many types of documents including any "information produced or sponsored by a corporation, partnership, firm or other legal entity about its business, such as information contained in annual reports, quarterly reports, SEC filings, and press releases, information about upcoming events, latest news about the entity, recent management presentations, briefings for analysts and portfolio managers, and the like." See col. 7 lines 19-29. Included in the type of items residing in the database is compliance information as it is a type of SEC filing, or lack thereof. Kitain also discloses that the database is acquired from a plurality of contributors. See col. 5 lines 15-21. Kitain discloses that the user of

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the system may choose any subset of the database to download. See col. 6 lines 1-9, col. 5 lines 63-67. These documents may be downloaded to the user's computer. See col. 5 lines 41-52. These documents may be viewed by the user in many ways including a computer-readable format. See col. 5 lines 21-32.

As to Claim 2, Kitain discloses that the system is accessible over communications links such as the Internet. See col. 5 lines 6-14.

As to Claim 3, Kitain discloses that one of the existing financial database systems used in the art today includes the EDGAR database. See col. 4 lines 19-30. Therefore, Kitain teaches that the invention may be used with the EDGAR database.

As to Claim 4, Kitain discloses that the database includes such items as "information produced or sponsored by a corporation, partnership, firm or other legal entity about its business, such as information contained in annual reports, quarterly reports, SEC filings, and press releases, information about upcoming events, latest news about the entity, recent management presentations, briefings for analysts and portfolio managers, and the like." This includes such documents as a prospectus.

As to Claim 9, the elements of the claim are rejected in the analysis above and the claim is rejected on that basis. (See rejections of Claims 3 and 6).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-7, 11-31 are all rejected under 35 U.S.C. 103(a) as being unpatentable over Kitain et al USPAT 5,864,871.

As to Claim 5, Kitain discloses a method by which a user may search for a phrase in a financial database and retrieve items in the database that contain that phrase. See col. 8 lines 38-57. The phrase searched may be a ticker symbol, corporate name or any other identifying word. Kitain does not explicitly disclose that there is an central index key that is matched with the given phrase. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that a database search engine will match a search phrase with a central index key. It is a common practice in the art to use unique index keys to reference items in a database. The UNIX and Windows 3.1 operating systems, for example, use unique identifiers to reference files. Using this technique is efficient and conforms with standard practice in the art.

As to Claim 6, Kitain discloses a system by which a user may search for and retrieve specific types of financial data relating to one corporation. See col. 7 lines 42-67. The user may specify, among other things, corporate highlights, SEC documents, or annual or quarterly reports. See col. 7 lines 50-55. Included in the type of data residing in the database is compliance

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information as it is a type of SEC filing, or lack thereof. The user may view or download only those aspects of the data that the user desires. See coil. 7 lines 65-67. Kitain does not disclose that the system identifies the start and the end of the desired information before it extracts it. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to do so because it is a necessary step in downloading a particular database item. It is a standard operation in the art to identify the start and the end of a piece of information to be retrieved before it is retrieved. For example, "inode" numbers in the UNIX operating system identify the exact location (from beginning to end) of a file on a hard disk.

As to Claim 7, Kitain discloses a search language (columns 22-31) which has the capability to search many different aspects of a database item including, for SEC filings, release date and submit date. See col. 26 lines 39-46. Kitain also discloses that the language may be extended to include many other aspects. See col. 26 lines 12- 14. Kitain does not disclose that the effective date of compliance information or amendment data regarding compliance information may be identified. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to do so because this data is an integral part of compliance information. The search language of Kitain was disclosed to be extendable to include many other aspects of financial data including these types of compliance data.

As to Claim 11, Kitain discloses that the financial database includes files of many types. See col. 5 lines 36. Kitain does not disclose that the accessing system includes a document processor for converting retrieved files into another document format. However, it would have

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been obvious to one of ordinary skill in the art at the time of the invention to do so because it is common in the art for software programs to include the capability to convert files to other format. Because the number of different file types increases every year, it is common for software programs to include conversion features to allow for greater compatibility.

As to Claims 12 and 18, Kitain discloses a method by which a list of documents that have been recently added to the central financial database may be retrieved. See col. 6 lines 1-9. Kitain also discloses that the user may choose any subset of the database to download or retrieve for further searching. See col. 6 lines 1-9, col. 5 lines 63-67. These documents may be downloaded to the user's computer. See col. 5 lines 41-52. Kitain does not disclose that document identifiers may be recorded for future reference. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to do so because it is common in the art to record document identifiers for future reference. For example, in the UNIX operating system, links to files make use of document identifiers for future reference. Kitain also does not disclose a process for extracting desired information from a document by marking the lines of text in the document, identifying a start and end line of the desired information and copying the marked lines of text. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to do so because the described process is a common way of copying desired information from a document. For example, the "file diff" utility in the UNIX operating system uses such a process for copying desired sections of files.

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As to Claims 13 and 19, the elements of the claims are rejected in the analysis above and the claims are rejected on that basis. (See rejections of Claim 3 and Claim 12).

As to Claims 14 and 20, the elements of the claims are rejected in the analysis above and the claims are rejected on that basis. (See rejection of Claim 7).

As to Claims 15 and 22, Kitain discloses a system by which desired financial data is stored on a computer that is connected to the Internet via a web server. See col. 5 lines 6-15. A web server is a type of file server.

As to Claims 16 and 23, Kitain does not disclose a system by which line numbers in a document are marked with unique numbers. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to do so because unique numbers would be necessary if lines of text are marked simultaneously in several documents. Because Kitain discloses that many documents are searched simultaneously, it would follow that lines of text are marked simultaneously in more than one document.

As to Claims 17 and 24, Kitain does not disclose a system by which start and end lines are identified at least two times independently. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to do so because it is a common form of error correction coding. The most simple form of error correction coding is to repeat a calculation or a transmission to reduce the probability of error.

As to Claim 21, the elements of the claim are rejected in the analysis above and the claim is rejected on that basis. (See rejection of Claim 7).

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As to Claims 25 and 28, the elements of the claims are rejected in the analysis above and the claims are rejected on that basis. (See rejections of Claim 6 and 7 regarding compliance information, rejection of Claim 12 regarding document identifiers and marking lines of text, and rejection of Claim 2 regarding a communications link.)

As to Claims 26 and 30, the elements of the claims are rejected in the analysis above and the claims are rejected on that basis. (See rejection of Claim 4 regarding the types of documents anticipated by Kitain. A mutual fund prospectus is anticipated by Kitain.).

As to Claims 27, 29 and 31, the elements of the claims are rejected in the analysis above and the claims are rejected on that basis. (See rejection of Claim 5, regarding the use of a unique identification numbers for each security).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitain et al USPAT 5,864,871 further in view of Cwenar USPAT 5,893,079. Kitain discloses a system by which effective date information is identified for compliance information. See rejection of Claim 7. Kitain does not disclose a system by which compliance information is reviewed for correctness. Cwenar, however, discloses a system by which certain acts on a system including a financial information database are reviewed to ensure compliance with a set of rules. See col. 2 lines 41-51. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Kitain and Cwenar because it would have been efficient to combine rules of compliance with a database so that actions made upon the data within the database is automatically checked for compliance.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Terry whose telephone number is (703) 306-5644. The examiner can normally be reached on Monday to Friday from 9AM to 5PM. The FAX phone number is (703) 309-5403

If any attempt to reach the examiner is unsuccessful, the examiner's supervisor, Thomas Black, can be reached at (703) 305-9707.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 305-9600.

MT

August 16, 1999


WAYNE AMSBURY
PRIMARY PATENT EXAMINER